

REMARKS

Claims 1-3 were amended to replace "high molecular weight" with "long chain." Support for the amendments can be found throughout the specification at, for example, p. 2, lns. 17-29 and 33-35 and p. 4, lns. 9-11.

Claims 1 and 12 were amended to explicitly recite that the admixture was free of emulsifier to define the invention over the cited documents. Support for the amendments can be found throughout the specification at, for example, Examples 1-3.

Claims 1 was amended to explicitly recite that the viscosity of admixture at 70°F to define the invention over the cited documents. Support for the amendments can be found throughout the specification at, for example, p. 4, lns. 1-7.

It is submitted that no new matter has been added by the above amendments. Approval and entry of the amendments is respectfully solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page(s) is/are captioned "Version with markings to show changes made".

Indefiniteness rejections

Claims 1, 4-14, 17, and 18 were rejected under 35 USC §112, second paragraph. (Paper No. 6 at 2.)

In making the rejection, the Examiner asserted that "the phrase 'high molecular weight' in claim 1 is not defined by the claim, the specification does not provided a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention."

The Examiner's comments are well taken. Claims 1, 2, and 3 have been amended to replace the term "high molecular weight alcohol" with "long chain alcohol." With these amendments, it is submitted that this ground of rejection is moot. Therefore, the rejection should be removed.

In another aspect of the rejection, the Examiner asserted that "the term 'long chain' in claim 12 is relative which renders the claim indefinite." In particular, the Examiner asserted that:

- the term was not defined in the claim,
- the specification does not provide a standard for ascertaining the requisite degree, and
- one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The Examiner concluded that "[t]he claim is indefinite as to the fatty alcohols encompassed thereby."

For the reasons set forth below, the rejection is traversed

At the outset, the term "long chain" does not stand alone in the claim. Rather, the term modifies the type of alcohol that is within the scope of the claimed subject matter. Thus, it is submitted that the term "long chain" cannot be read in a vacuum, as the Examiner appears to have done.

In another aspect of the rejection, the Examiner asserted that "claim 10 recites the limitation 'long chain alcohol' in line 1." The Examiner concluded that there was "insufficient antecedent basis for this limitation in the claim."

Claim 1, from which claim 10 depends, has been amended to recite long chain alcohol. With this amendment, this ground of rejection is moot. Therefore, the rejection should be withdrawn.

Obviousness Rejection

Claims 1-10 were rejected under 35 USC §103(a) as being unpatentable over Cain et al. (EP 0 901 804) ("Cain") in view of Kimura (CAPLUS abstract, 1994:321866) ("Kimura"), Hohmen Oil CO. (CAPLUS abstract, AN 1986:18914) ("Hohmen"), and Tanaka (CAOLUS abstract, AN 1989:153130) ("Tanaka"). (Paper No. 6 at 3.)

For the reasons set forth below the rejection, respectfully is traversed.

Cain discloses a fat dispersion having at least one fat, a particulated sweetener, and a viscosity reducing component. (p. 2, lns 17-18.) The fat was disclosed as being cocoa butter or fractions thereof, illipe or fractions thereof, palm oil fractions, palm kernel oil or factions thereof, polyol poly esters and saturated triglycerides with fatty acid residues with mixed chain length, in particular having 2-12 and 16-24 C-atoms. (p. 3, lns. 6-8.) The sweetener was disclosed as being selected from glucose, fructose, sucrose, maltose, lactose, sorbitol,

lactitol, mannitol, maltitol, xylitol, maltodextrin and polydextrose. (p. 2, lns. 56-58.) The viscosity-reducing component was disclosed as being a long chain alcohol having from 24-34 C-atoms. (p. 2, lns. 26, 34-54.) The Examples disclose preparing various chocolate formulations. In preparing the various formulations, the chocolate was melted, liquid cocoa butter was then added, and depending on the formulation, octacosanol was added. (Example I) Example I disclosed that, all other ingredients being equal, octacosanol lowered the viscosity at 50°C from 0.33 Pas (no octacosanol) to 0.28 Pas (0.4% octacosanol). Example II disclosed that, without the cocoa butter, 0.4% octacosanol decreased the viscosity from 0.46 Pas (no cocoa butter, no octacosanol) to 0.33 (no cocoa butter, 0.4% octacosanol) at 50°C. Example III disclosed that hardened oil fractions did not decrease the viscosity at 50°C. Example IV disclosed the effect of adding the long chain alcohol as a solid and, among other things, the addition of an emulsifier, lecithin, to the formulation. This produced viscosities of 0.2025 Pas and 0.1956 Pas at 70°C. Example IV disclosed the effect of different sources of long chain alcohols.

Kimura discloses preparing a test liquid for administering intragastrically to mice having C 22-38 aliphatic alcohols, tocopherol (I), octacosanol (II) and corn oil. (Abst.) The results demonstrated that octacosanol distributed higher in every tissue and organ than a test liquid having polyoxyethylene sorbitan monooleate instead of tocopherol and corn oil.

Hohmen discloses dissolving vitamin E, soybean lecithin, and octacosanol in vegetable oil. The dissolved solution was then encapsulated.

Tanaka discloses preparing an emulsified beverage by solubilizing octacosanol by fats and oils, water-soluble emulsifiers, and oil soluble emulsifiers, then mixing with aqueous solutions.

In making the rejection, the Examiner asserted that "Cain teaches a fat-containing product and the method of making the same." (Paper No. 6 at 3.) The Examiner asserted that Cain's mixture had reduced viscosity. The Examiner acknowledged, however, that Cain "does not expressly teach the employment of the particular vegetable oil or the particular food products herein, such as non-continuous oil phase products. (Paper No. 6 at 4.)

To fill the acknowledged gap, the Examiner relied upon Hohmen and Kimura as "teaching the employment of vegetable oil, such as soybean oil and corn oil for solubilization of fatty alcohols." The Examiner also relied on Tanaka as "teaching employing oil-fatty alcohol mixture for making oil in water emulsion.).

While the Examiner never enunciated a reasoned conclusion that the claimed invention would have been obvious to one of ordinary skill in the art, the following is presented to expedite prosecution on the merits.

At the outset, amended independent claim 1, independent claim 12, and independent claim 17 each affirmatively required that the claimed oil/alcohol admixture have a viscosity of less than about 200 centipose (0.2 Pas) at 70°F. Cain does not disclose or suggest such a viscosity at the measured temperature. Cain took viscosity measurements at 50°C (122°F) and 70°C (158°C). The lowest viscosity measurement at 50°C (122°F) using octacosanol in Cain's disclosure was 0.28, which is not only at a temperature over 50 degrees higher than the claimed measurement temperature, but is also 40% greater viscosity at that higher temperature than that which is explicitly claimed. Further, at 70°C (158°C), which more than twice the claimed temperature for measuring viscosity, Cain discloses viscosities of 0.2025 and 0.1956. Such numbers were achieved by Cain using not only a greater temperature for measuring viscosity, but adding, among other things, an emulsifier. Therefore, it is submitted that in addition to the acknowledged gap, Cain also does not disclose or suggest methods and compositions having a long chain alcohol and edible oil admixture having the affirmatively required viscosity.

A *prima facie* case of obviousness requires that the rejection describe with specificity why one skilled in the art would have combined two references to arrive at the claimed invention. In the present case, no such explanation is found in the rejection.

Cain was concerned with preparing fat continuous dispersions for confectionery compositions. Kimura was concerned with the distribution of octacosanol in tissue and organs of mice after administration. The Examiner has not provided the requisite specific motivation for one of ordinary skill in art to combine the cited documents. It is submitted that one of ordinary skill in the art would not combine Kimura with Cain. For this reason, the rejection is improper and should be removed.

Similarly, there is no suggestion to combine Cain and Hohmen. Cain was concerned with preparing fat continuous dispersions for confectionery compositions. Hohmen was concerned with formulating a vitamin, emulsifier and octacosanol in a gelatin capsule. The Examiner has not provided the requisite specific motivation for one of ordinary skill in art to combine the cited documents. It is submitted that one of ordinary skill in the art would not combine Kimura with Cain. For this reason, the rejection is improper and should be removed.

Tanaka expressly requires an emulsifier. There is no suggestion or motivation in Tanaka to eliminate the use of an emulsifier. Nor does Cain provide such motivation. Therefore, Cain alone, or in combination with Tanaka do not provide the requisite suggestion or motivation to not use an emulsion in the claim methods and compositions. For this reason, the rejection based on Cain in view of Tanaka is improper and should be removed.

Accordingly, for the reasons set forth above, entry of the amendments, withdrawal of the rejections and objections, and allowance of the claims is respectfully requested. If the Examiner has any questions regarding this paper, please contact the undersigned.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claim 1 was amended as follows:

1. A process for preparing a comestible product containing ~~high molecular weight~~ long chain alcohols comprising:

providing a ~~high molecular weight~~ long chain alcohol;

providing an edible oil containing less than about 12 weight percent linolenic acid that is substantially free of medium chain triglycerides composed of C₈ to C₁₀ fatty acids;

admixing said high molecular alcohols in said edible oil to form a high molecular weight alcohol/edible oil admixture that contains less than two weight percent high molecular weight alcohol, free of an emulsifier, and has a viscosity of less than 200 centipose measured at 70°F, and combining said admixture with other components of a comestible product.

Claim 2 was amended as follows:

2. The process of claim 1 wherein the ~~high molecular weight~~ long chain alcohol is policosanol.

Claim 3 was amended as follows:

3. The process of claim 1 wherein the ~~high molecular weight~~ long chain alcohol is octacosanol.

Claim 12 was amended as follows:

12. Method for preparing a long chain alcohol in an edible oil material comprising:

providing an edible oil substantially free of medium chain triglycerides composed of C₈-C₁₀ triglycerides and containing less than about 10 weight percent linolenic acid;

providing a long chain alcohol;

admixing said edible oil and long chain alcohol in the presence of an energy source such that the long chain alcohol is admixed in the oil; said long chain alcohol/edible oil admixture is stable and ~~substantially~~ free of an emulsifier or surfactant; and having a viscosity of less than about 200 centipose as measured at 70 °F.